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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/781,924

02/18/2004

Robert B. Franks

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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

12/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/781,924 | Applicant(s) FRANKS, ROBERT B. | |
| | Examiner Yogesh C. Garg | Art Unit 3625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/29/2008 has been entered.
2. Claims 18, 19 are currently amended. Claims 1-17 and 21-30 were previously withdrawn. Claims 18-20 are pending for examination.

Response to Arguments

- 3.1. In view of the amendment to claim 18, rejection of claim 18 under 35 U.S.C. 112, second paragraph is withdrawn.
- 3.2. Since the certified copy of PCT/GB/2002/003858 filed August 19, 2002 is not supplied, the priority claim to foreign application GB01202134 filed 8/18/2002 is still denied.
- 3.3. Applicant's arguments filed 9/29/2008 with respect to currently amended claims 18-19 have been considered but are moot in view of the new ground(s) of rejection necessitated due to current amendments.

Priority

4. The applicant's arguments filed 9/29/2008 have been considered but are not persuasive because the instant application does not claim to be filed as a National Stage application of PCT/GB/2002/003858 under 371. Since the foreign filed application GB01202134 was filed more than 12 months earlier than the date of instant US application, the claim for priority is denied.

5 Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other relevant and related passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the other relevant and related passages and figures in the cited references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6.1. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the USPTO Web server in use (see the Reference numbers 2,3 and 4 in the IDS sheet 1 of PTO-1449 received from the applicant on 7/12/2004. All these Reference numbers represent web pages of the USPTO web server facilitating to register and file patent and trademark applications. While rejecting the claims, individual Reference numbers will be cited to reject the claims), hereinafter TEAS in view of Powell et al. (US 20010032189 A1), hereinafter Powell.

Note: Claims 18-20 are system claims. Claims directed to an Apparatus/system must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). In the instant case, the system claims 18-20 recite comprising transaction and user computer entities having operating interfaces and browsers respectively . Thus if the prior art teaches all the structural imitations of claims 18-20 and are capable of doing the intended functions then the prior art will read on the instant claims.

Regarding claim 18, TEAS (see Reference number 4 of IDS received on 7/12/2004) discloses a transaction system for collecting data describing a trade mark,

said data describing said trade mark being sufficient to satisfy the trade mark data requirements needed to file an application to register said trade mark (Note: The type of data is non-functional as it does not perform any manipulative function in coordination with a computer/processor and the computer system of TEAS/Powell is capable of receiving any digital data related to a trademark inclusive of audio/video/text data) ,said transaction system comprising:

a transaction computer entity, said transaction computer entity operating an interface, said interface capable of accepting a data file representing a trade mark And at least one user computer entity, said user computer entity comprising a browser, and a file system; wherein said interface allows said browser to: browse said file system of said user computer entity; select a data file stored on a data storage device of said user computer entity; and said interface inputs said selected data file to said transaction computer entity (see pages 1-3. TEAS filing system provides an interface to a user having a computer entity equipped with a browser to select form files from a file system and populate those files with data, such as text and images (for trademarks) and accept the populated files for registration).

TEAS does not disclose that the data file transmitted by the user from his computer and accepted by the transaction computer interface includes also at least one file selected from a set of a video file and audio file along with the text file and image file. However, Powell at the time of the applicant's invention, teaches transmitting and accepting data files [via a communication network] comprising text, audio and video files and storing them on a computer entity and processing them in the field of Trademark

(see at least paragraphs 253). In view of Powell, it would be obvious to one of an ordinary skilled in the art to combine the known teachings of Powel with TEAS, at the time of applicant's invention, because doing so would help a Trademark applicant to transmit video and audio files along with text and image files. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103." KSR, id. at 1741-42. Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734 (2007). It would amount to combining elements separately disclosed in TEAS and Roberts that is the TEAS interface receiving application data files including text and image and along with these files also receiving the audio and video files from the applicant as described in Powell.

Regarding claim 19, its limitations are closely parallel to the limitations of claim 18 as regards to transmitting and accepting data files comprising text files, audio files, image files and video files and are therefore analyzed and rejected on the basis of same rationale set forth for claim 18 above. As regards the limitation for creating a trade mark data file representing said trade mark data comprising all the files received, it is already taught by TEAS (see reference 4 of the said IDS) and in view of Powell, as analyzed above for claim 18 the data files received would include text files, image files,

audio files and video files [as need by the applicant and provided by him] and will be processed.

Regarding claim 20, reference 4 teaches that the transaction system as claimed in claim 19, wherein said interface is capable of serving a view containing an image selected from the set: a JPEG or a PDF image (see page 2 which teaches accepting JPG files).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex/Hoteling.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yogesh C Garg
Primary Examiner
Art Unit 3625

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Primary Examiner, Art Unit 3625